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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/816,255	03/26/2001	Gregory J. Meffert	CER0001-US	7263

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EXAMINER

SONG, HOSUK

ART UNIT	PAPER NUMBER
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2135

DATE MAILED: 02/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/816,255

Applicant(s)

MEFFERT ET AL.

Examiner

Hosuk Song

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 July 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-89 and 95-108 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 23-49, 77-89, 96-108 is/are allowed.
- 6) ☒ Claim(s) 1-22, 50-76 and 95 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 March 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>09816255</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

1. Claims 1-3,5,8-11,13-22,50-55,95 are rejected under 35 U.S.C. 102(e) as being anticipated by Smith et al(US 6,651,166).

Claims 1,5: Smith patent disclose an encryption services component generating key pairs and providing certificate management services in (fig.15). Smith discloses a PKI server being operable to function as at least one of a certificate authority and as a LDAP service provider in (col.5,lines 39-45). Smith disclose a user information database,a package database,a control server connected to the electronic network and operable to access the encryption services component, the PKI server,the user information database and the package database in (fig.12 and col.5,lines 55-65). Smith disclose wherein the control server receives encrypted content in the form of a package,wherein the package database stores the package,the package is sent back into the electronic network and package remains encrypted as it passed through the control server and stored in the package database in (fig.6 and col.4,lines 43-51;col.7,lines 19-24).

Claim 2: Smith discloses notification server is operable to notify an intended recipient of the package that the package is awaiting pickup in (col.7,lines 1-9).

Claim 3: Smith disclose notification server is connected to at least one of an email server, a paging device, a netcall device, a facsimile machine and a voice line in (col.7,lines 26-32).

Claim 8: Smith discloses control server is connected to the Internet in (col.8,lines 59-61).

Claim 9: Smith discloses control server is connected to the Internet via an SSL connection in (col.5,lines 24-28;col.6,lines 28-31).

Claim 10: Smith disclose control server is operable to communicate with a local agent that is associated with an electronic device which itself is accessible via the electronic network in (fig.8).

Claim 11: Smith discloses content is at least one of an email message,an email attachment,a document, a business transaction, a graphical and streaming audio or vide in (col7,lines 22-24).

Claim13: Smith disclose certificate management component in (col.7,lines 61-67).

Claims 14,95: Smith disclose a control server being operable to receive encrypted content from an electronic network, the encrypted content having been encrypted using at least one public key and a private key, at least one public key and private key having previously been obtained via the control server in (fig.14). Smith disclose a database server in communication with the control server, the database server being operable to store the encrypted content and store information indicative of a sender of the encrypted content and a recipient of the encrypted content in (col.7,lines 16-23). Smith disclose a notification server in communication with at least one of the control server and database server, the notification server being operable to notify the recipient of the encrypted content that the sender has sent encrypted content to the recipient, wherein the public key is obtained without an express command from the sender in (col.6,lines 5-15).

Claim 15: Smith disclose PKI server in (col.8,lines 26-30).

Claim 16: Smith discloses database server comprises at least one of a user information database,a transaction file database and an encrypted content database in (col.7,lines 37-45).

Claim 17: Smith disclose encryption services module operable to generate key pairs and digital certificates that are compatible with a PKI in (fig.15).

Claims 18,19: Smith discloses control server receives the encrypted content from a local agent that is in communication with the electronic network in (col.7,lines 16-23).

Claim 20: Smith discloses content is at least one of an email message,an email attachment,a document, a business transaction, a graphical and streaming audio or vide in (col7,lines 22-24).

Claim 21: Smith discloses control server is connected to the Internet in (col.8,lines 59-61).

Claim 22: Smith discloses public key is obtained via an LDAP service in (col.5,lines 39-44).

Claims 50-55: Smith disclose a high volume package component operable to receive sequential data files and operable to associate the data files with a plurality of account and certificate data,respectively,to create a plurality of packages in (col.7,lines 1-9,24-48). Smith disclose a high volume encryption component operable to implement PKI-based encryption on each of the packages and generate encrypted packages using the certificate data and a high volume transport component operable to receive the encrypted packages and send each package to its intended recipient based on the account data in (col.5,lines 23-45).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 4,6-7,12,56,68,57-67,69-76 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smith et al(US 6,651,166).

Claims 4,6: Smith does not specifically disclose transaction files database for tracking package traffic. Official notice is taken that transaction files database for tracking package traffic is well known in the art. One of ordinary skill in the art would have been motivated to employ transaction files database for tracking package traffic in order to minimize data congestion and route packages to authorized destination.

Claim 7: Smith does not specifically disclose an audit database. Official notice is taken that audit database is well known in the art. One of ordinary skill in the art would have been motivated to employ audit database in order to improve and maximize data efficiency rate.

Claim 12: Smith does not disclose dissemination rule. It would have been obvious to person of ordinary skill in the art to modify the invention of Smith to employ dissemination rule in order to prevent illegal deletion or modification by the receiver.

Claims 56,68: Smith disclose creating the content,launching a local agent associated with the email client,passing the content and an address of a recipient to the local agent and obtaining a public key associated with the recipient in (col.7,lines 15-32). Smith discloses encrypting the content using the public key and a private key;transmitting the package to a control server which is operable to forward the package to the recipient in (fig.9,13). Smith does not disclose dissemination rule. It would have been obvious to person of ordinary skill in the art to modify the invention of Smith to employ dissemination rule in order to prevent illegal deletion or modification by the receiver thus protecting its ownership/authorship.

Claim 57: Smith discloses content is at least one of an email message, an email attachment, a document, a business transaction, a graphical and streaming audio or video in (col. 7, lines 22-24).

Claims 58-59: Smith discloses local agent comprises an application specific interface that provides an interface to the email client in (col. 7, lines 24-32).

Claim 60: Smith does not disclose dissemination rule comprises at least one of do not copy, do not print, do not forward and self-destruct. It would have been obvious to person of ordinary skill in the art to modify the invention of Smith to employ dissemination rule in order to prevent illegal deletion or modification by the receiver so that ownership can be protected against tampering.

Claim 61: Smith discloses automatically obtaining the public key of the recipient by accessing the control server in (fig. 8).

Claim 62: Smith discloses control server accesses at least one of a certificate authority server and a LDAP directory service in (col. 8, lines 1-11).

Claim 63-64: Smith discloses notifying the recipient of an awaiting package in (fig. 14).

Claims 65-67: Smith discloses control server stores the package until the package is requested by the recipient in (fig. 13, 14).

Claim 69: Smith discloses content is at least one of an email message, an email attachment, a document, a business transaction, a graphical and streaming audio or video in (col. 7, lines 22-24).

Claims 70-76: Smith discloses content is at least one of an email, an email attachment, a business transaction, a document and a graphics file in (col. 7, lines 22-24 and fig. 13, 15).

Claim Objections

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3. Claim 64 is objected to because of the following informalities: Typo "suing" should be using. Appropriate correction is required.

Allowable Subject Matter

4. Claims 23-49,77-89,96-108 are allowed.

Claim 23: Prior art of record does not teach an application specific interface being capable of interfacing with the messaging application to access and pass content and address information to and from the messaging application and update status information within the messaging application and the local agent being operable to receive unencrypted content from the message application,encrypt the content using a public/private key pair and local agent further being operable to receive encrypted content from the electronic network,launch a local agent-controlled window,decrypt the encrypted content using a private key and display decrypted content in the local agent-controlled window.

Claims 34,77: Prior art of record does not teach sender local agent being operable to receive content generated on the sender electronic device,generate a package of encrypted content using PKI-based encryption by obtaining at least one public key from one of the control server and a local registry and send the package to the control server;the control server being operable to receive the package from the sender local agent and transmit the package to the recipient local agent; launch a recipient local-controlled window,decrypt the encrypted content in the package and display decrypted content within the recipient local agent-controlled window.

Claim 96: Prior art of record does not teach generating, by the sender local agent, a package content using an encryption scheme by obtaining data necessary to implement the encryption scheme from one of the control server and local register;sending the package at the control server and notifying the recipient of an awaiting package;receiving by the recipient local agent the package from the control server;launching a recipient local agent-controlled

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window;decrypting the encrypted content in the package and displaying the decrypted content within the recipient local agent-controlled window.

Claims 24-33,35-49,78-89,97-108 are allowed because of dependency.

Response to Applicant's Remark

5. Applicant has elected claims 1-89,96-109. However, examiner noticed a typo in previous office action.

Group I: Claims 1-89,96-109; should be claims 1-89,95-108

Group II: Claims 90-93; should be claims 90-94

Therefore, examiner will treat claims 1-89,95-108 as elected claims.

Conclusion

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hosuk Song whose telephone number is 571-272-3857. The examiner can normally be reached on Tue-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kim Vu can be reached on 571-272-3859. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

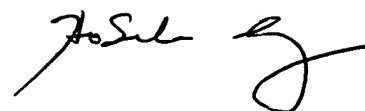
Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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A handwritten signature in black ink, appearing to be "J. S. Lee" followed by a stylized flourish.